

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Joseph P. Fredrick

Art Unit : 1743

Serial No. : 10/643,424

Examiner : GORDON, BRIAN R

Filed : August 19, 2003

Confirmation No. 4523

Title : Apparatus For Substrate Handling

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REPLY TO RESTRICTION REQUIREMENT

This Reply to Restriction Requirement is being submitted in response to the Office Action mailed March 5, 2007, for the above-captioned application. The Examiner set a 31-day period for response. This reply is being filed on or before its current due date of April 5, 2007.

In the Office Action, the Examiner required the following restriction under 35 U.S.C. 121:

- Group I: Claims 1-18 and 29-44, drawn to a device for conducting processing steps on a substrate, classified in class 422, subclass 68.1.
- Group II: Claims 19-28, drawn to a method for conducting processing steps on a substrate, classified in class 436, subclass 46.
- Group III: Claims 45-46, drawn to a flow device, classified in class 422, subclass 68.1

In response, Applicant elects Group I, claims 1-18 and 29-44, with traverse. The restriction requirement is respectfully traversed for the reasons set forth below.

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (a) The inventions must be independent or distinct as claimed; and
 - (b) There must be a serious burden on the Examiner if restriction is not required.
- MPEP §803. If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. *Id.*

In this case, the Group I and Group III claims can be searched and examined together without serious burden on the Examiner. These two groups are classified in the same class and subclass, and their claim elements overlap. Consequently, the criterion under MPEP §803(b) is not satisfied. The restriction requirement indicates that Inventions I and III¹ are related as subcombinations disclosed as usable together in a single combination. Subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. The restriction requirement asserts that the subcombination of Group III has separate utility such as separating a substrate and cover, while Group I is for separating fluid from a substrate. Applicant disagrees, as certain embodiments in Group I can separate a substrate and cover as well; see, for example, claims 12 and 13. Therefore, examining claims 45 and 46 in addition to claims 12 and 13 would not impose much additional burden on the Examiner.

Accordingly, Applicant respectfully requests that Groups I and III be joined to a single group containing claims 1-18 and 29-46. Upon such joining, Applicant would elect the new group of claims 1-18 and 29-46.


¹ The restriction requirement states "Inventions I and II are related..." in Paragraph 3 on page 2, which apparently means "Inventions I and III are related..."

Early examination of this application on the merits is earnestly solicited. Should the Examiner have any questions, a telephone call to the undersigned attorney for the Applicant would be appreciated.

Respectfully submitted,

JOSEPH P. FREDRICK

By


Ping Y. Hwung
Reg. No. ~~44,164~~

IP Administration
Agilent Technologies, Inc.
Legal Department, DL-429
P.O. Box 7599
Loveland, CO 80537-0599

Date: **April 3, 2007**
Phone: **(408) 553-3738**